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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/773,183	01/30/2001	Christopher Maroney	81866.0031	4481
26021	7590	04/13/2004	EXAMINER	
HOGAN & HARTSON L.L.P. 500 S. GRAND AVENUE SUITE 1900 LOS ANGELES, CA 90071-2611			PWU, JEFFREY C	
		ART UNIT		PAPER NUMBER
				3628

DATE MAILED: 04/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/773,183	MARONEY, CHRISTOPHER
	Examiner Jeffrey Pwu	Art Unit 3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_ is/are allowed.
- 6) Claim(s) 1-16 is/are rejected.
- 7) Claim(s) \_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

For a claim to be statutory under 35 USC 101 the following two conditions must be met:

- 1) In the claim, the practical application of an algorithm or idea result in a useful, concrete, tangible result, AND
- 2) The claim provides a limitation in the technological art that enables a useful, concrete, tangible result.

As to the technology requirement, note MPEP Section iV 2(b). Also note In Re Waldbaum, 173USPQ 430 (CCPA 1972) which teaches “useful arts” is synonymous with “technological arts”. In re Musgrave, 167USPQ 280 (CCPA1970), In re Johnston, 183USPQ 172 (CCPA 1974), and In re Toma, 197USPQ 852 (CCPA 1978), all teach a technological requirements.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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4. Claims 1-16 are rejected under 35 U.S.C. 102(e) as being unpatentable over Nieboer et al. (US 6,418,419).

Nieboer et al. disclose claims:

1. A system facilitating transfer of an asset in a private negotiation following a public negotiation, the system including:

a transaction controller (10) identifying at least one participant for a private negotiation from a set of participants from a public negotiation in which one or more participants negotiated for purchase of an asset ; and

a message generator (12) coupled to the transaction controller, the message generator forwarding a message to the at least one participant for the private negotiation inviting the at least one participant to engage in a private negotiation for the purchase of the asset,

the message generator (12) outputting information to the at least one participant representative of at least an identification of the asset, an identification of a party offering the asset, an identification of the at least one participant and a current offer or bid price for the asset, the server outputting the information in response to the transaction controller indicating that the at least one participant will participate in the private negotiation (col.1, lines 50-60; col.2, lines 5-55; col.3, lines 15-30).

2. The system of claim 1, wherein the asset is a domain name registration (col.5, line 55-col.7, line 63).

3. The system of claim 2, wherein the transaction controller receives a message indicating termination of a first private negotiation in which the asset was not transferred and

subsequently identifies a second participant for a second private negotiation and causes the message generator to forward a message to the second participant for the second private negotiation (col.11, line 65-col.12, line 45);

wherein the transaction controller receives a message indicated that the second participant will engage in the second private negotiation and the transaction controller causes the message generator to output information to the second participant representative of at least an

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identification of the asset, an identification of a party offering the asset, an identification of the at least one participant and a current offer or bid price for the asset (col.11, line 65-col.17, line 24).

4. The system of claim 3, wherein the transaction controller identifies the at least one participant and the second participant from a rank ordering of participants in the public negotiation, the rank ordering based on final bid of the participants in the public negotiation (col.11, line 65-col.17, line 24).

5. The system of claim 1, wherein the transaction controller identifies a first and second participant for a first and a subsequent private negotiation, respectively, from a rank ordering of participants in the public negotiation, the rank ordering based on final bids of the participants in the public negotiation, with a highest final bid identifying the first participant in the first private negotiation (col.1, lines 50-60; col.2, lines 5-55; col.3, lines 15-30).

6. A system facilitating transfer of an asset in a sequence including at least one private negotiation following a multilateral negotiation, the system including:

a first computer adapted to connect through a network to at least one server, the server accessing and serving data representative of a multilateral negotiation for an asset and at least a first state of a first bilateral negotiation for the asset, the first state identifying a seller and a first bidder from the multilateral negotiation to engage in the first bilateral negotiation (col.1, lines 50-60; col.2, lines 5-55; col.3, lines 15-30);  
the first computer receiving messages directed to the first bidder in the bilateral negotiation, including a first message inviting the first bidder to engage in the first bilateral negotiation (col.1, lines 50-60; col.2, lines 5-55; col.3, lines 15-30);

wherein, upon the first bidder initiating the first bilateral negotiation, the first computer receiving the first state of the first bilateral negotiation and generating a first screen illustrating a present state of the first bilateral negotiation (claims 23-24).

7. The system of claim 6, wherein the multilateral negotiation is an auction (10).

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8. The system of claim 6, wherein the asset is a domain name registration (10).
9. The system of claim 8, wherein the multilateral negotiation is an auction (10).
10. The system of claim 8, wherein the first message includes a URL for a bilateral negotiation website (14).
11. The system of claim 6, wherein the first screen includes:

(See col.1, lines 50-60; col.2, lines 5-55; col.3, lines 15-30; col.11, line 65-col.12, line 45)

  - an identification of the asset that was subject to the multilateral negotiation;
  - a countdown clock for displaying a remaining time for the first bilateral negotiation; a current offer price;
  - a counteroffer section for making a counteroffer against a previous offer; an option section for terminating the first bilateral negotiation;
  - a history section for displaying a history of offers; and
  - a list of bidders and outcomes of negotiations, the list viewable only by the seller.
12. The system of claim 11, wherein the first message includes a URL for a bilateral negotiation website (14).
13. The system of claim 12, wherein the asset is a domain name registration (10).
14. The system of claim 6, wherein participants eligible for any bilateral negotiation consist of a registrant of the domain name registration and a plurality of bidders rank ordered in accordance with values of the bidder's final bid in the multilateral negotiation (col.1, lines 50-60; col.2, lines 5-55; col.3, lines 15-30; col.11, line 65-col.12, line 45).

15. The system of claim 14, wherein the first bilateral negotiation is followed by a second bilateral negotiation, each session being limited to the registrant of the domain name and one bidder (10).

16. The system of claim 15, wherein the multilateral negotiation is an auction (10).

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey Pwu whose telephone number is 703 308-7835. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sam Sough can be reached on 703 308-0505. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jeffrey Pwu  
  
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**JEFFREY PWU**  
**PRIMARY EXAMINER**